REMARKS

Claims 1-16 and 61-72 are pending in this action.

Claims 1-16 and 61-72 were previously rejected under 35 USC 103(a) as being unpatentable over Call (USP 6,418,441) in view of the W3C reference provided by way of IDS by the Applicants; however, Applicants note with appreciation that this rejection has been withdrawn.

The Examiner's rejections are traversed without amendment in this response.

Rejections under 35 USC 103(a)

The Examiner's principal reference is McKendrick, *Banks begin to play with XML*, Bank Technology News, Sep 1998, Vol. 11, Iss. 9, pg.6, 2 pgs. Applicants do not consider McKendrick enabling or even suggestive of any particular interface specification or data structure, much less the interface specification claimed. To call to mind the claimed interface specification, we repeat the part of claim 1 that follows the preamble:

> a machine readable specification of an interface to transaction processes stored in memory accessible by at least one node in the network, including interpretation information providing a definition of an input document, and a definition of an output document, the definitions of the input and output documents comprising respective descriptions of sets of storage units and logical structures for the sets of storage units.

The issue is what McKendrick enables or teaches regarding the claimed machine readable specification of an interface.

It is black letter law that references relied upon for a section 103 rejection must provide an enabling disclosure, i.e. they must place the claimed invention in the possession of the public. 1 Chisum on Patents § 3.04 [1][b][v] to [1][c]. The clearest cases requiring that a reference make an enabling disclosure are in the chemical arts, where enablement is often an issue. *See, id., citing, In re Brown*, 329 F.2d 1006, 141 USPQ 245 (CCPA 1964); *In re Payne*, 606 F.2d 303, 314-15, 203 USPQ 245 (CCPA

1979) ("References relied upon to support a rejection under 35 U.S.C. 103 must provide an enabling disclosure, i.e., they must place the claimed invention in the possession of the public ... .")

McKendrick does not teach or enable any machine readable specification of an interface. This is particularly clear when it is remembered that a machine readable specification of an interface is embodied in a data structure. The McKendrick reference makes no effort to teach or enable any data structure, much less the claimed machine readable specification of an interface. The passage on which the Examiner relies, in its entirety, says:

> As such, XML may be just the ticket for providing better customer service. 'Customer services are now migrating to Web cites from call centers and physical locations,' states a report from Microsoft Corp. 'And, because most of these business applications involve manipulation and transfer of data-such as purchase orders, invoices, customer information and appointments, XML will allow a rich array of business applications to be implemented.'

Compared, for instance, to a volume written by Professor Knuth, this passage says nothing about data structures. It mentions data, but it does not teach or enable a user to harness any particular data structure in order to process a purchase order or invoice.

Combining McKendrick with the XML specification gives no hint regarding constructing a machine readable specification of an interface, as the XML specification is agnostic towards its application. The proposed combination does not create a specification comprising interpretation information including a definition of an input document and an output document. The proposed combination does not even suggest whether a purchase order or invoice should be considered an input document or an output document. This combination really teach nothing about how to apply XML to solve business problems.

The Examiner obviously must disagree. It may be that the old examining technique of drawing a picture based on the McKendrick reference will persuade the

Examiner that it does not teach any particular data structure. What picture can the Examiner draw to illustrate McKendrick? How can the Examiner justify arguing that McKendrick is an enabling disclosure of that picture, as opposed to any other abstract depiction of this two page news report? How does the Examiner even know whether to label a purchase order "input" or "output"? How can the Examiner extract from McKendrick a picture of an interface specification comprising interpretation information including a definition of an input document and an output document? It just isn't there.

It should not be surprising that off-hand mention of purchase orders and invoices in a two page news flash does not enable the same invention as a 113 page disclosure accompanied by 16 figures.

CONCLUSION

Applicants respectfully submit that the claims, as stated herein, are in condition for allowance and solicit acceptance of the claims, in light of these remarks. If the Examiner disagrees and sees amendments that might facilitate allowance of the claims, a call would be appreciated.

In the past, telephone conferences have been useful in advancing this application. A further telephone conference is requested, if the Examiner does not consider the claims to be in condition for allowance.

Should any questions arise, the undersigned can ordinarily be reached at his office at 650-712-0340 from 8:30 to 5:30 PST, M-F and can be reached at his cell phone 415-902-6112 most other times.

Respectfully submitted,

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Ernest J. Beffel, Jr., Reg. No. 43,489

HAYNES BEFFEL & WOLFELD LLP
P.O. Box 366
Half Moon Bay, CA 94019
(650) 712-0340 phone
(650) 712-0263 fax